

### REMARKS

Claims 1-53 were pending in the non-final Office Action sent February 3, 2010. Claims 1, 52, and 53 are being amended. New claims 54-55 are being added. Support for the claim amendments and new claims can be found in the specification at least in paragraphs [0066] - [0085]. Reconsideration and further examination are respectfully requested.

### Examiner Interview

The Applicant thanks Examiner Brandenburg for the courtesies of an interview conducted on March 22, 2010. The Applicant and the Examiner discussed various limitations of claim 1, including the feature of "delivering, from the server at a second later time, the second electronic document including the electronic advertisement" as well as the features added in new claims 54 and 55. The Examiner and the Applicant agreed that the interview aided the mutual understanding of the invention.

### § 112 Rejections

Claims 1, 18-35, and 53 were rejected under 35 U.S.C. § 112 as allegedly being indefinite. In order to expedite prosecution and without conceding to the rejections, claims 1, 35, 52, and 53 have been amended, and claims 18-23 have been cancelled. Therefore, the Applicant respectfully request the Examiner withdraw the § 112 rejections.

### § 103 Rejections

Claims 1-12, 14-15, 18-29, 31-32, 35-46 and 48-49 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2003/0146939 (Petropoulos). Claims 13, 16, 30, 33, 47, and 50 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of U.S. Patent Application Publication No. 2002/0165767 (Ogura). Claims 17, 34, and 51 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of Ogura as applied to claims 13, 16, 30, 33, 47 and 50 above, in further in view of U.S. Patent Application Publication No. 2003/0032677 ("Morgenthaler"). Claim 51 was rejected under 35 U.S.C. § 103(a) as allegedly

being unpatentable over Petropoulos in view of Morgenthaler. The Applicant respectfully traverses these rejections.

Claim 1 recites “delivering, from the server at a first time, the first electronic document including the electronic advertisement including the compact display format, the expanded display format, and the code, the electronic advertisement initially displayed in the first electronic document in the compact display format so as to **enable a client device to transition from the compact format to the expanded format without further interaction with the server**; including the electronic advertisement with the second electronic document, the electronic advertisement displayed in the second electronic document in the expanded display format; and delivering, from the server at a second later time, the second electronic document including the electronic advertisement.”

The relied upon portions of Petropoulos describe allowing a user to see both a search result and a preview of the underlying information described by the search result (i.e., a preview of the webpage linked to by the result). The relied upon portions of Petropoulos do not teach or suggest “**delivering . . . at a first time, the first electronic document including the electronic advertisement including the compact display format, the expanded display format, and the code, the electronic advertisement initially displayed in the first electronic document in a compact display format so as to enable a client device to transition from the compact format to the expanded format without further interaction with the server.**” The search results, the alleged electronic advertisement, as discussed above, do not include the three of the “**compact display format, an expanded display format, and the code . . . so as to enable a client device to transition from the compact format to the expanded format without further interaction with the server,**” as recited in claim 1. The relied upon portions of Petropoulos do not disclose or suggest delivering at a first time the search result (the alleged electronic advertisement) including the search result 53 (the alleged compact display format), the preview window 55 (the alleged expanded display format), and code. Therefore, Petropoulos does not teach or suggest “delivering . . . the first electronic document including the electronic advertisement including the compact display format, the expanded display format, and the code, the electronic advertisement initially displayed in the first electronic document in a compact display format so as to enable a

client device to transition from the compact format to the expanded format without further interaction with the server,” as recited in claim 1.

The relied upon portions of Petropoulos also do not teach or suggest “identifying a second electronic document including content from the referenced network location associated with the menu option selected; [and] **including the electronic advertisement with the second electronic document,**” as recited in claim 1. In fact, the concept of “identifying” a document and “including the electronic advertisement **with the second document**” are completely missing from the relied upon portions of Petropoulos.

The Examiner agrees that Petropoulos does not teach or suggest “including the electronic advertisement . . . and delivering, from the server, a second electronic document including content from the referenced network location associated with the menu option selected and including the second electronic advertisement,” as recited in claim 1. *See* Office Action, page 9. The Examiner indicates on page 9 of the Office Action:

“Petropoulos does teach that actual content or the web page referred by or associated with the first result 53 is displayed as preview information . . . this preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results in a call to the referenced page. . . . it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering a second document including the referenced content and the electronic advertisement initially displayed in the expanded format. The rationale for this inclusion is that this would enable Petropoulos to deliver the content while maintaining the advertisement content in direct view of the user . . . The examiner understands the actual content or web page that is displayed as preview information to be expanded display format of the instant invention . . . Furthermore the examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e., menu options( which in turn calls upon activation to its respective referenced pages, the returned content referenced by the hyperlinks would be the actual content or web page delivered as web page (i.e., second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements.

The Examiner states that “this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents

both of these elements,” however, the relied upon portions of Petropoulos discloses only the actual content or web page being delivered, and not the “electronic advertisement with the second electronic document.” The electronic document and the second electronic document are separate and not one item, whereas in Petropoulos only the content is delivered which the Examiner states represents both of these elements. However, claim 1 recites “including the electronic advertisement with the second electronic document” so they are not the same, as the Examiner indicates.

The relied upon portions of Ogura and Morgenthaler also do not teach or suggest the claimed subject matter missing from Petropoulos namely “delivering, from the server at a first time, the first electronic document including the electronic advertisement including the compact display format, the expanded display format, and the code, the electronic advertisement initially displayed in the first electronic document in the compact display format so as to enable a client device to transition from the compact format to the expanded format without further interaction with the server; including the electronic advertisement with the second electronic document, the electronic advertisement displayed in the second electronic document in the expanded display format; and delivering, from the server at a second later time, the second electronic document including the electronic advertisement” as recited in claim 1.

Accordingly, the relied upon portions of Petropoulos, Ogura, and Morgenthaler taken alone or in combination, do not teach or suggest each and every element of claim 1, and therefore, cannot support a rejection of this claim under 35 U.S.C. § 103(a). Reconsideration and withdrawal of the rejection are respectfully requested and deemed appropriate for at least these reasons. Claims 2-17 depend from claim 1 and are allowable for at least the same reasons set forth above with respect to claim 1.

Claim 35 is directed to an apparatus including “including the electronic advertisement in the second electronic document in the expanded second display format, the electronic advertisement included in a first frame in the second electronic document, wherein the content from the referenced network location is included in the second electronic document in a second frame, separate from the first frame.” Claim 35 is allowable for at least some of the same reasons set forth above with respect to claim 1.

Claim 52 is directed to a method including “including the electronic advertisement with the second electronic document; and delivering, from the server at a second later time, the second electronic document including the electronic advertisement.” Claim 52 is allowable for at least some of the same reasons set forth above with respect to claim 1.

Claim 53 is directed to a method including “including the electronic advertisement with the second electronic document; and delivering, from the server at a second later time, the second electronic document including the electronic advertisement.” Claim 53 is allowable for at least some of the same reasons set forth above with respect to claim 1.

New claims 54 and 55 recites “, wherein the electronic advertisement is included in a first frame in the second electronic document, and wherein the content from the referenced network location is included in the second electronic document in a second frame, separate from the first frame.

The relied upon portions of Petropoulos are silent on *any* disclosure or teaching of frames, much less “the electronic advertisement included in a first frame in the second electronic document, wherein the content from the referenced network location is included in the second electronic document in a second frame, separate from the first frame,” as recited in claim 1. Therefore, the relied upon portion of Petropoulos does not teach or suggest “ the electronic advertisement included in a first frame in the second electronic document, wherein the content from the referenced network location is included in the second electronic document in a second frame, separate from the first frame,” as recited in claim 1.

#### Conclusion

For the foregoing reasons, the Applicant submits that all the claims are in condition for allowance. By responding in the foregoing remarks only to particular positions taken by the Examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the Applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the Applicant's decision to amend or cancel any claim should not be understood as implying that the Applicant agrees with any positions taken by the Examiner with respect to that claim or other claims.

Applicant : Koningstein  
Serial No. : 10/748,681  
Filed : December 31, 2003  
Page : 15 of 15

Attorney's Docket No.: 16113-0639001

The required fees are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: May 3, 2010

/Leila R. Abdi/  
Leila R. Abdi  
Reg. No. 52,399

**Customer No. 26192**  
Fish & Richardson P.C.  
Telephone: (404) 892-5005  
Facsimile: (877) 769-7945

12120658.doc